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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/695,761 | 10/30/2003 | Kazunobu Yokotani | 033995-001 | 6904 |

21839 7590 06/15/2004

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EXAMINER

LUM VANNUCCI, LEE SIN YEE

ART UNIT PAPER NUMBER

3611

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/695,761

Applicant(s)

YOKOTANI ET AL.

Examiner

Lee Lum

Art Unit

3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The disclosure is objected to because in the Spec, p 1, first section, a foreign application cannot be incorporated into the present application.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 1, the paragraph beginning with "a brake mechanism" is unclear because of the last statement, "by human power...". As best understood, this paragraph appears to describe a human-powered brake assembly.

Claim 3 is unclear. For example, one interpretation is if the "displacement amount" is smaller than the predetermined value, the brake mechanism is not activated. Clarification/amendment is required.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

As best understood, Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Pennebaker et al 4221275.

As best understood, Pennebaker discloses an electric bicycle comprising
Human-powered drive mechanism comprising elements P/6/8,

Motor drive mechanism (unidentified in col 2, line 37) for auxiliarily driving the front wheel (col 2, line 40),

Battery 16,

Brake lever 20, and a brake mechanism (unidentified, inherent) not driven by the motor drive mechanism, as best understood,

The mechanism braking the bicycle when the lever is displaced more than a predetermined value (col 2, lines 44-53), as best understood,

Control circuit 14 for controlling the motor so that it is regeneratively braked when the brake lever is operated.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

A. **Claim 4** is rejected under 35 U.S.C. 103(a) as being unpatentable over Pennebaker in view of Goldenfeld 4637274.

Pennebaker does not disclose a battery capacity indicator, while Goldenfeld shows this element in fig 5 (voltmeter). It would have been obvious to one with ordinary skill in the art at the time the invention was made to include this feature, as shown in Goldenfeld, to advise of the battery capacity, and thus determine if the battery has adequate capacity to operate the vehicle.

B. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Pennebaker in view of Garfinkle et al 3921741.

Pennebaker does not disclose control of the motor as including high and low power, while Garfinkle shows throttle 20 with this capability (col 2, lines 63-65). It would have been obvious to one with ordinary skill in the art at the time the invention was made to include this feature, as shown in Garfinkle, to permit the user to control the amount of assist power, thus increasing safety and enjoyment.

C. **Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Pennebaker in view of Eguchi 6320336.

Pennebaker does not disclose an indicator for regenerative braking, while Eguchi shows this feature in col 11, lines 14-16. It would have been obvious to one with ordinary skill in the art at the time the invention was made to include this arrangement, as shown in Eguchi, to advise the user as to the particular state of motor activity, and whether this particular state is functionally properly, thus increasing safety and comfort.

5. The prior art made of record, and not relied upon, is considered pertinent to the disclosure: Lee et al 6446745, Whittaker 6155369, Miyata 5777442, Gannon 5316101, 5237263, McCulloch et al 3921745, Bialek 3841428.


6. Communication with USPTO/Examiner

Any inquiry concerning this communication, or others, should be directed to Ms. Lum at 703 305-0232, M-F, 9-6. If attempts to reach the examiner are unsuccessful, her supervisor, Ms. Lesley Morris is at 703 308-0629. Our fax number is 703 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications: private PAIR only, for published applications: private or public PAIR. For more information re PAIR: <http://pair-direct.uspto.gov>. Questions re private PAIR: contact the Electronic Business Center (EBC) at 866 217-9197.

Ms. Lee S. Lum
Examiner
6/7/04




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